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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,084	12/06/2001	Kiichi Adachi	2130US	2648

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EXAMINER

SAUCIER, SANDRA E

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 03/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/010,084

Applicant(s)

Adachi et al.

Examiner

Sandra Saucier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 17, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above, claim(s) 1-7 and 20-49 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19 is/are allowed.
- 6) ☒ Claim(s) 8-18 is/are rejected.
- 7) ☐ Claim(s) is/are objected to.
- 8) ☐ Claims are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Dec 6, 2001 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s).
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6 6) ☐ Other:

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DETAILED ACTION

Claims 1-49 are pending. Claims 8-19 are considered on the merits. Claims 1-7, 20-49 are withdrawn from consideration as being drawn to a non-elected invention.

Election/Restriction

Claims 1-7, 20-49 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention. Election was made **without** traverse in Paper No. 10. Please note that Groups II and III were rejoined as requested by applicant because no undue burden was found in the examination of both of these distinct inventions.

Claim Rejections – 35 USC § 112

INDEFINITE

Claims 8-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is uncertain if step a) is a separate step from step b) and the determining step is one of measuring the difference between step a) and b) as is usual in enzyme activity/inhibitor determinations. Or if in step b) an inhibitor is added to the mixture of step a) and somehow the change in products is then measured. If so, what is the change measured against, that is, what is the control? Please clarify step c), such as “determining the change in concentration of ... (products) between step a) and step b) etc..

Claim Rejections – 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action: A person shall be entitled to a patent unless (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent, (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States, (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or (2) a patent granted on an application for patent by another filed in the United

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States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 8 and 18 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Houston *et al.* [U].

The claims are directed to a process for screening a test compound as an antibiotic comprising

- a) contacting L-histidinol phosphate and water with a histidinol-phosphatase;
- b) contacting L-histidinol phosphate and water with histidinol-phosphatase and a test compound; and
- c) determining the change in concentration of (one of the products of the reaction), wherein a change in concentration for any of the products indicates that the test compound is a candidate for an antibiotic.

The reference is relied upon as explained below.

Houston *et al.* disclose a method of determining if compounds inhibit histidinol phosphatase activity by comparing the amount of product produced in the presence and absence of the compound tested. This appears to be the same active steps as in the presently claimed method.

Although the intent of the reference is not the same as applicant's intent as stated in the preamble, the active steps of the method are identical as applicant's active steps. Thus, the method appears to be anticipated. Please note that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

A histidinol phosphatase isolated from *S. typhimurium* or baker's yeast would have at least a 50% sequence identity with histidinol-phosphatase by definition.

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Allowable Subject Matter

Claims 9-17 appear to be directed to allowable subject matter.

Claim 19 is allowed.

To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1651. The supervisor for 1651 is M. Wityshyn, (703) 308-4743. The normal work schedule for Examiner Saucier is 8:30AM to 5:00 PM Monday and Tuesday and 8:30 AM to noon on Wednesday.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Saucier whose telephone number is (703) 308-1084. **Status inquiries must be directed to the Customer Service Desk at (703) 308-0197 or (703)-308-0198.** The number of the Fax Center for the faxing of official papers is (703) 872-9306 or for after finals (703) 872-9307.



Sandra Saucier
Primary Examiner
Art Unit 1651
March 11, 2003